

support for the features added to claims 120-128 can be found, for example, on page 4, lines 29-30 and in Figure 2 of Applicant's specification. No new matter has been added.

The attached Appendix includes a marked-up copy of each rewritten paragraph (37 C.F.R. §1.121(b)(1)(iii)) and claim (37 C.F.R. §1.121(c)(1)(ii)).

Applicant appreciates the Examiner's indication that claims 80 and 81 would be allowable if rewritten to overcome the rejection of the claims under 35 U.S.C. §112, second paragraph and to include all the features of the base claim and any intervening claims. However, for the reasons discussed below, Applicant submits that all pending claims are allowable.

Page 3 of the Office Action states that claims 87-97 are withdrawn from consideration. However, Applicant submits that claim 87, as amended, is closely related to the originally presented claim directed to a mold. Accordingly, Applicant respectfully requests rejoinder and consideration of claims 87-97.

The specification is objected to for failing to provide proper antecedent basis for the zones of weakness which extend longitudinally beyond a bottom of the inner cavity of the mold, as recited in claim 75. The specification has been amended responsive to the objection. It is respectfully requested that the objection be withdrawn.

Claims 5 and 75 are objected to for minor informalities. Claims 5 and 75 have been amended responsive to the objection. It is respectfully requested that the objection be withdrawn.

Claims 1-10, 55-65, 68, 69 and 74 are rejected under 35 U.S.C. §112, first paragraph for containing new matter. Applicant submits that Applicant's original Fig. 2 clearly illustrates that the inner surface of the mold is seamless. Thus, Applicant submits that original Fig. 2 provides antecedent basis for the seamless feature recited in the claims, and thus no new matter has been added by amending the claims to describe the seamless inner

surface shown in Applicant's Fig. 2. It is respectfully requested that the rejection be withdrawn.

Claims 6, 7, 16, 17, 27, 28, 38, 39, 49, 50, 60, 61 and 80 and 81 are rejected under 35 U.S.C. §112, second paragraph for including the word "close" and for a minor informality in claim 80. Applicants have amended claims 6, 16, 27, 38, 49, 60 and 80 to recite "the depth of the notches decreases on coming towards a bottom end of the mold" responsive to the rejection. Claim 80 has also been amended to depend from claim 78 responsive to the rejection. It is respectfully requested that the rejection be withdrawn.

Claims 1-5, 9, 33-37, 42-48, 53, 54, 69, 72, 73, 75-79 and 84-86 are rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 3,934,810 to Henning, and claims 6-8, 10, 38-41, 49-52, 82 and 83 are rejected under 35 U.S.C. §103(a) over Henning. The rejections are respectfully traversed.

Applicant submits that the teachings of Henning, which relate to molds for foundry products, are not analogous to the subject matter recited in claims 1, 33, 44 and 75 (i.e., molds for cosmetic products). In the Federal Circuit case of *In re Clay*, 23 USPQ 2d 1058 (Fed. Cir. 1992), the court set forth the following two criteria for determining whether prior art is analogous: (1) whether the art is from the same field of endeavor, and (2) if the reference is not within the field of the inventor's endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved.

First, Applicant submits that Henning is not from the same field of endeavor of Applicant's claims relating to a mold for a cosmetic product because Henning discloses flexible distensible molds for shaping art forms and other materials, such as hardenable foundry sand mixes, for the productions of cores and molds (col. 1, lines 3-6). In addition, Applicant submits that foundry sand products are of a different nature than cosmetic products because, for example, the products are made for preparing molds for molten metal as opposed to preparing molded cosmetics. Thus, Applicant submits that Henning is not from the same

field of endeavor of Applicant's claims 1, 33, 44 and 75 which disclose molds for cosmetic products.

Secondly, Applicant submits that Henning is not reasonably pertinent to the problem with which Applicant's invention is involved. The object of Henning is to disclose a flexible mold for which the withdrawal bore of the shaping cavity can be greatly enlarged and the side walls can be greatly extended with lower air pressure differentials than would otherwise be necessary (Abstract). In contrast, the primary object of Applicant's claims is to make it easier to select the material for constituting a mold (pg. 2, lines 2-3 of Applicant's specification). In particular, Applicant's claims teach a mold which can be made from materials that increase the lifetime of the mold (pg. 2, lines 3-5 of Applicant's specification). By providing a mold with a side wall which includes zones of weakness, the mold can be made out of materials that are less flexible than those presently in use, but are stronger than the materials presently in use (pg. 2, lines 15-23).

Thus, Applicant submits that Henning is not analogous to the subject matter recited in claims 1, 33, 44 and 75 because not only is Henning not from the same field of endeavor of Applicant's claims 1, 33, 44 and 75, Henning is also not reasonably pertinent to the particular problem which claims 1, 33, 44 and 75 overcome.

Accordingly, because Henning is not analogous to the subject matter recited in Applicant's claims 1, 33, 44 and 75, one of ordinary skill in the art at the time of Applicant's invention would not look to the teachings of Henning to disclose claims 1, 33, 44 and 75. Further, nowhere does Henning disclose or suggest a mold for manufacturing a stick of a cosmetic product, as recited in claims 1, 33, 44 and 75. Thus, Applicant submits that Henning fails to disclose or suggest a mold for manufacturing a stick of a cosmetic product, as recited in claims 1, 33, 44 and 75.

For at least these reasons, Applicant submits that Henning fails to disclose or suggest all the features of claims 1-5, 9, 33-37, 42-48, 53, 54, 69, 72, 73, 75-79 and 84-86, and also

fails to render obvious the features recited in claims 6-8, 10, 38-41, 49-52, 82 and 83. It is respectfully requested that the rejections be withdrawn.

Claims 11-32, 55-68, 70, 71 and 74 are rejected under 35 U.S.C. §103(a) over Henning as applied to claims 1-10, 33-54, 69, 72, 73, 75-79 and 82-86, and further in view of U.S. Patent No. 3,937,438 to Fox et al. (hereinafter "Fox"). The rejection is respectfully traversed.

Page 10 of the Office Action acknowledges that Henning fails to teach a mold having a cavity with a sloping bottom wall, as recited in claim 11; a mold having a part formed by two successive conical surfaces converging towards an opening of the mold, as recited in claim 22; and a mold having an opening defined at least partially by a conical surface, the conical surface having a seamless inner wall, as recited in claim 55. Page 10 of the Office Action states that Fox overcomes the deficiencies of Henning, as applied to claims 11, 22 and 55.

However, as discussed above, Henning fails to disclose or suggest a mold for manufacturing a stick of a cosmetic product, as recited in claims 11, 22, and 55. Fox relates to the same field as Henning, i.e., flexible molds for shaping art forms and other articles, such as hardenable foundry sand mixes for the production of cores and molds (col. 1, lines 2-6). As discussed above, foundry products are of a different nature than cosmetic products because, for example, the products are made for preparing molds for molten metal as opposed to preparing molded cosmetics. Accordingly, Henning and Fox relate to the same field of endeavor and have the same objective (i.e., disclose a flexible mold for which the withdrawal bore of the shaping cavity can be greatly enlarged and the side walls can be greatly extended with lower air pressure differentials than would otherwise be necessary). Accordingly, for the reasons discussed above with regard to Henning, Applicant submits that the teaching of Fox is also not analogous to the subject matter recited in claims 11, 22 and 55 because not only is Fox not from the same field of endeavor of Applicant's claims 11, 22 and 55, Henning

is also not reasonably pertinent to the particular problem which claims 11, 22 and 55 overcome. Thus, the teachings of Henning and Fox are not analogous to the subject matter recited in claims 11, 22 and 55.

For at least these reasons, Applicant submits that the combination of Henning and Fox fails to disclose or suggest all the features of claims 11, 22, and 55, and thus fails to render obvious the features recited in claims 11-32, 55-68, 70, 71 and 74. It is respectfully requested that the rejection be withdrawn.

Further, with regard to added claim 99, Applicant submits that Henning, either alone or in combination with Fox, fails to disclose or suggest a mold for manufacturing a stick, wherein the mold has at least one notch facilitating radial deformation of the mold and the notch having a depth decreasing along a length of the notch towards a bottom end of the mold. Applicant submits that, in Henning, the slits (87) have a constant depth, as shown in Figs. 7 and 8 of Henning.

With regard to claims 100-119 Applicant submits that claims 100-114 and 115, 116 and 117, and 118 and 119 are allowable for at least the reasons discussed above with regard to claims 99, 87 and 1, respectively, and for the additional features recited in each of claims 100-119.


Finally, with regard to added claims 120-128, Applicant submits that Henning, either alone or in combination with Fox, fails to disclose a mold, wherein the zones of weakness are recesses in the side wall of the mold, the recesses having a width such that there is at least one gap in an outer boundary of the side wall of the mold when the mold is at rest, as recited in claims 120-128.

Applicant submits Henning and Fox explicitly disclose closed slits 27, having walls which abut against each other when the mold is "at rest" (col. 2, lines 55-60 of Henning; col. 3, lines 23-25 of Fox et al.). Thus, Henning and Fox teach away from a mold which has gaps in the outer boundary of the side wall of the mold when the mold is at rest.

In view of the foregoing, Applicant submits that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1-128 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in better condition for allowance, the Examiner is invited to contact Applicant's undersigned representative at the telephone number set forth below.

Respectfully submitted,


William P. Berridge
Registration No. 30,024

Maryam M. Ipakchi
Registration No. 51,835

WPB:MMI/ccs

Attachments:

Appendix

Petition for Extension of Time
Amendment Transmittal

Date: March 20, 2003

OLIFF & BERRIDGE, PLC
P.O. Box 19928
Alexandria, Virginia 22320
Telephone: (703) 836-6400

<p>DEPOSIT ACCOUNT USE AUTHORIZATION Please grant any extension necessary for entry; Charge any fee due to our Deposit Account No. 15-0461</p>
--

APPENDIX

Changes to Specification:

Page 4, line 35 - page 5, line 3:

The recesses 12 create zones of weakness which make it easier to deform the mold radially as mentioned above, while the zones of greater thickness between the recesses 12 ensure that the shape of the mold remains stable while the composition is being cast and while it is cooling, in particular. As shown in Figure 1, the recesses 12 creating the zones of weakness may extend longitudinally beyond a bottom wall 4 of an inner cavity of the mold.

Changes to Claims:

Claims 98-128 are added.

The following is a marked-up version of the amended claims:

1. (Amended) A mold for manufacturing a stick of a cosmetic product, wherein the mold has a seamless inner surface and a side wall which includes zones of weakness facilitating radial deformation thereof.
4. (Amended) A mold according to claim 2, ~~where in~~ wherein said recesses are constituted by notches that are uniformly distributed in a periphery of the mold.
5. (Amended) A mold according to claim 4, wherein a bottoms of said notches are rounded.;
6. (Amended) A mold according to claim 4, wherein a depth of the notches decreases on coming towards ~~elose to~~ a bottom end of the mold.
11. (Amended) A mold for manufacturing a stick of a cosmetic product, wherein the mold has a side wall, which includes zones of weakness facilitating radial deformation thereof, and wherein the mold has a cavity with a sloping bottom wall.
16. (Amended) A mold according to claim 14, wherein a depth of the notches decreases on coming ~~eloser to~~ towards a bottom end of the mold.

22. (Amended) A mold for manufacturing a stick of a cosmetic product, wherein the mold has a side wall which includes zones of weakness facilitating radial deformation thereof and wherein the mold has a cavity having a part formed by two successive conical surfaces converging towards an opening of the mold.

27. (Amended) A mold according to claim 25, wherein a depth of the notches decreases on coming ~~closer to~~ towards a bottom end of the mold.

33. (Amended) A mold for manufacturing a stick of a cosmetic product, wherein the mold has a side wall, which includes zones of weakness facilitating radial deformation thereof, and wherein the mold has a top portion having a flange.

38. (Amended) A mold according to claim 36, wherein a depth of the notches decreases on coming ~~closer to~~ towards a bottom end of the mold.

44. (Amended) A mold for manufacturing a stick of a cosmetic product, wherein the mold has a side wall which includes zones of weakness facilitating radial deformation thereof and wherein the mold has a flange surrounding an opening of the mold.

49. (Amended) A mold according to claim 47, wherein a depth of the notches decreases on coming ~~closer to~~ towards a bottom end of the mold.

55. (Amended) A mold for manufacturing a stick of a cosmetic product, wherein the mold has a side wall which includes zones of weakness facilitating radial deformation thereof and wherein the mold has an opening defined at least partially by a conical surface, the conical surface having a seamless inner wall.

60. (Amended) A mold according to claim 58, wherein the depth of the notches decreases on coming ~~closer to the~~ towards a bottom end of the mold.

75. (Amended) A mold for manufacturing a stick of a cosmetic product, wherein the mold has a side wall which includes ~~zone~~ zones of weakness facilitating radial deformation thereof, at least one of said zones of weakness extending longitudinally beyond a

bottom of an inner cavity of said mold.

80. (Amended) A mold according to claim ~~80~~ 78, wherein the depth of the notches decreases on coming ~~closer to~~ towards a bottom end of the mold.

87. (Amended) A method for manufacturing a stick of a cosmetic product, comprising:

pouring said product in a mold having a side wall which includes zones of weakness;

_____ facilitating radial deformation thereof ~~a cosmetic product~~; and

_____ ~~applying a suction to the outside of the mold for expanding the mold.~~

91. (Amended) A method according to claim 90, wherein ~~the bottoms~~ of the said notches are rounded.